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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,733

03/16/2004

Kazuto Yamamoto

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EXAMINER

WILLS, LAWRENCE E

ART UNIT

PAPER NUMBER

2609

MAIL DATE

DELIVERY MODE

08/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,733

Applicant(s)

YAMAMOTO ET AL.

Examiner

Lawrence E. Wills

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/16/2004; 5/16/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the "image forming program" is functional descriptive material, since the program is not imparting functionality to a control unit or on a computer readable medium. The claim rejection can be overcome by changing "image forming program" to "image forming program stored on a computer readable medium" or "image forming program stored on a memory unit and retrieved to be executed by a control unit".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-34** are rejected under 35 U.S.C. 102(b) as being anticipated by Teraura (US Patent 6,827,279).

With regard to claim 1, Teraura teaches an electronically tagged printed matter 13 (Figure 1) wherein image data is printed on an electronically tagged printing paper equipped with an electronic tag 14 (Figure 1) for storing electronic data in a certain part of the printing paper 13a(Figure 1), and said electronic tag stores image data printed on said electronically tagged printing paper, (Figure 1, Column 4, lines 20-35; in addition Column 7, lines 23-24)

With regard to claims 2, 6, 12, 16, 22, 26, and 32, Teraura teaches electronically tagged printed matter 13 (Figure 1) wherein said electronic tag 14 (Figure 1) transmits or receives electronic data by means of wireless communications, (Figure 5, Column 4, lines 47-49).

With regard to claims 3, 13, 23, Teraura teaches an image forming device 1 comprising a printing unit 11 for printing image data on an electronically tagged printing paper 13 (Figure 1) equipped with an electronic tag 14 for storing electronic data in a certain part of the printing paper, and a writing unit (15-17) for writing the image data printed by said printing unit on said electronic tag, (Figure 5, Column 7, lines 37-50)

With regard to claims 4, 14, and 24, Teraura teaches an image forming device 1 comprising a receiving unit 31 for receiving image data from other devices

Art Unit: 2609

where a printing unit prints image data received by said receiving unit, (Figure 5, Column 7, lines 3-50).

With regard to claims 5, 15, and 25, Teraura teaches an image forming device 1 comprising a scanning unit 6 for acquiring image data by scanning a document image (Column 10, lines 5-8), wherein said printing unit 11 prints image data acquired by said scanning unit, (Figure 5, Column 12, lines 58-61).

With regard to claims 7, 17, and 27, Teraura teaches an image forming device 1, comprising a reading unit 15-17 (Figure 5) for reading image data from an electronically tagged printed matter 13 (Figure 1) wherein image data is printed on an electronically tagged printing paper 13 equipped with an electronic tag 14 for storing electronic data in a certain part of the printing paper 13a and said electronic tag stores image data printed on said electronically tagged printing paper (Column 8, lines 25-27); and a printing unit 11 for printing the image data read by said reading unit, (Column 7, lines 48-50)

With regard to claims 8, 18, and 28, Teraura teaches an image forming device 1 comprising: a judging unit 29 for judging whether a document is said electronically tagged printed matter or not, (Column 7, lines 8-9); a transporting unit 31,32 for transporting the document to a specified position when said judging unit

Art Unit: 2609

judges that the document is not said electronically tagged printed matter, reading unit reads image data from the electronic tag of the untransported document on said transporting unit when said judging unit judges that the document is said electronically tagged printed matter (Figure 6, in addition, column 7, lines 3-50); a scanning unit 6 for scanning the image data of the document transported by the transport unit; and a second printing unit 40 for printing the image data scanned by said scanning unit, wherein said transport unit does not transport the document when said judging unit judges that the document is said electronically tagged printing document,, (Figure 6, in addition, column 12, lines 30-65, column 7 lines 55-67).

With regard to claims 9, 19, and 29, Teraura teaches an image forming device comprising a display unit 35 for displaying a notice that the document is an electronically tagged printed matter when said judging unit 29 judges that the document is said electronically tagged printed matter; and a selecting unit 34 for selecting whether the image data stored in the electronic tag of the document should be printed or not; wherein said reading unit reads out image data from the electronic tag of the document when said selecting unit selects that the image data stored in the electronic tag of the document should be printed. (Column 7, lines 55-67)

With regard to claims 10, 20, and 30, Teraura teaches an image forming device comprising: a second reading unit (15-17) for reading out modifiable attribute

Art Unit: 2609

information (permission data) among attribute information of said electronically tagged printed matter from said electronic tag; a display unit 35 for displaying the modifiable attribute information read out by said second reading unit; and a modifying unit 34 for modifying the modifiable attribute information read out by said second reading unit, wherein said printing unit prints image data based on the attribute information modified by said modifying unit. (Column 8, line 28 –Column 9, line 15)

With regard to claims 11, 21, and 31, Teraura teaches an image forming device 1 wherein said printing unit 11 (Figure 5) prints image data on an electronically tagged printing paper 13 equipped with an electronic tag 14 (Figure 1) for storing electronic data in a certain part of the printing paper, further comprising: a writing unit 15 for writing the image data printed by said printing unit on the electronic tag of the electronically tagged printing paper on which the image data is printed by said printing unit, (Step A4, A5 in Figure 6, in addition, Column 7, lines 3-50)

With regard to claims 33 and 34, Teraura teaches a computer readable recording medium on which an image forming program is recorded, (Column 6, lines 50-53).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kiwada (US 2005/0162697, US 2005/0141009, US 2005/0141004), Yano(US 2004/0109194), Minami et al. (US 7,048,194).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence E. Wills whose telephone number is 571-270-3145. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/800,733

Page 8

Art Unit: 2609

LEW

August 7, 2007



ALEXANDER EISEN

PRIMARY EXAMINER

TECHNICAL